

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: July 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Consejo Regulador del Tequila, A.C.*

*v.*

*George Michalopoulos and Tasos Georgas*

—  
Opposition No. 91244395

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Marie Anne Mastrovito of Abelman Frayne & Schwab  
for Consejo Regulador del Tequila, A.C.

John Zaharopoulos of Parker Law Firm PLLC  
for George Michalopoulos and Tasos Georgas.

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Before Cataldo, Pologeorgis and Johnson,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicants, George Michalopoulos and Tasos Georgas, seek registration on the Principal Register of the standard character mark TEQUILUSA, identifying “alcoholic beverages, except beer” in International Class 33.<sup>1</sup>

Opposer, Consejo Regulador del Tequila, A.C., opposes registration on the grounds of priority and likelihood of confusion under Trademark Act Section 2(d), deceptive

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<sup>1</sup> Application Serial No. 87861148 was filed on April 3, 2018, based upon Applicant’s assertion of a bona fide intent to use the mark under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

misdeshriptiveness under Trademark Act Section 2(e)(1), and deceptiveness under Trademark Act Section 2(a). Opposer pleads ownership of Registration No. 5225126 for the certification mark TEQUILA, issued in typed form<sup>2</sup> on the Principal Register, identifying “distilled spirits, namely, spirits distilled from the blue tequilana weber variety of agave plant,” in International Class A with the following certification statement:

The certification mark “Tequila”, as used by persons authorized by the Consejo Regulador del Tequila, A.C. (“CRT” or “Certifier”), certifies that (1) the goods are manufactured in Mexico from a specific variety of the blue agave plant grown in certain regions of Mexico as defined by Mexican law and standards; (2) the goods are manufactured in Mexico in compliance with Mexican law and standards including fermentation, distillation, aging, the percentage of blue agave sugars and physical-chemical specifications; and (3) the finished product is or contains within it the goods manufactured in accordance with (1) and (2) above.<sup>3</sup>

In their answer, Applicants admit the following allegations:

1. Applicants are seeking to register the mark TEQUILUSA for “alcoholic beverages, except beer.” (Answer, Par. 4);
2. Applicants are individuals residing in the United States. (Answer Par. 7); and
3. Applicants do not have offices or factories in Mexico. (Answer Par. 8).

Applicants otherwise deny the salient allegations in the notice of opposition.<sup>4</sup>

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<sup>2</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks”).

<sup>3</sup> Issued on June 20, 2017, from application Serial No. 78286762, filed on August 13, 2003.

<sup>4</sup> 4 TTABVUE. Because Applicants did not pursue their pleaded affirmative defenses by motion or at trial, they are deemed waived. *See, e.g., Harry Winston, Inc. v. Bruce Winston*

## **I. The Record**

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application. In addition, during its assigned testimony period, Opposer submitted the following evidence by notice of reliance:<sup>5</sup>

1. A copy of its pleaded registration showing current title and status;
2. An excerpt from the Alcohol and Tobacco Tax and Trade Bureau (“TTB”) website entitled “Certificate of Age and Origin Requirements for Imported Alcoholic Beverages” showing that the U.S. government recognizes that products labeled as TEQUILA must come from Mexico and that such products must have a certificate of authenticity issued by Opposer;
3. Another excerpt from the website of the Alcohol and Tobacco TTB showing that Tequila has long been recognized as a distinctive product of Mexico made under Mexican law and the strict requirements for products to be labelled as TEQUILA which lead to its high quality;
4. Dictionary definitions and a Wikipedia entry; and
5. Copies of third-party registrations.

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*Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014) (pleaded affirmative defenses not pursued in the brief considered waived).

<sup>5</sup> 5 TTABVUE.

Applicant did not submit any testimony or evidence. Only Opposer filed a brief.

## II. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1061-62 (Fed. Cir. 2014); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187-89 (CCPA 1982) *see also, e.g., Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1344 (TTAB 2017). In order to meet the standing requirement, a plaintiff need only show that it has a real interest, i.e., a personal stake, in the outcome of the proceeding, and a reasonable basis for its belief of damage. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012). A belief in likely damage can be shown by establishing a direct commercial interest. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). If a plaintiff establishes its standing with respect to any pleaded ground for opposition, it has the right to assert any other ground as well, that also has a reasonable basis in fact. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982).

Opposer's standing in this proceeding is established by its pleaded registration, shown in the record to be valid and subsisting, and owned by Opposer.<sup>6</sup> *Cunningham*, 55 USPQ2d at 1844; *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012).

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<sup>6</sup> 5 TTABVUE 7-17.

### III. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claim, Opposer must prove, by a preponderance of the evidence, that it has priority in the use of its mark and that use of Applicants’ mark is likely to cause confusion, mistake, or deception as to the source or sponsorship of Applicant’s goods, *Cunningham*, 55 USPQ2d at 1848, even in the absence of contrary evidence or argument. *Threshold TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1040 (TTAB 2010). Further, our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261

(Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687-88 (Fed. Cir. 1993). The *DuPont* factors relevant to this proceeding are discussed below.

A. Priority of Use

Because Opposer's pleaded registration is of record, priority is not an issue with respect to the goods identified in the registration. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

B. The nature and similarity or dissimilarity of the goods and the established, likely-to-continue trade channels.

We first consider the second and third *DuPont* factors, the similarity or dissimilarity of Applicants' goods and the goods certified by Opposer, and the parties' established, likely-to-continue trade channels. The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration," *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

As previously noted, Opposer's TEQUILA mark is a certification mark. Our precedent clarifies that the classification as a certification mark "has very little effect on our determination as to whether or not there is a likelihood of confusion." *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012). As further stated in that case:

The test for determining likelihood of confusion with respect to certification marks is the same as that applied to trademarks, i.e., the du Pont analysis. However, because the certification mark owner does not itself use the mark, the question of whether there is a likelihood of

confusion is based on a comparison of the mark as applied to the goods or services of the certification mark users. (citations omitted). Other issues relating to the goods and services, including the channels of trade and purchasers therefor, are determined from the standpoint of the users as well.

*Id.* (quoting *Motion Picture Ass'n of America, Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559 (TTAB 2007)).

With the foregoing in mind Opposer's TEQUILA mark is used by persons certified by Opposer to certify:

...that (1) the goods are manufactured in Mexico from a specific variety of the blue agave plant grown in certain regions of Mexico as defined by Mexican law and standards; (2) the goods are manufactured in Mexico in compliance with Mexican law and standards including fermentation, distillation, aging, the percentage of blue agave sugars and physical-chemical specifications; and (3) the finished product is or contains within it the goods manufactured in accordance with (1) and (2) above.

Thus, we must determine whether Applicants' goods are related to the goods provided by users of Opposer's certification mark. *See Motion Picture Assn. of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d at 1562.

We find that Applicants' broadly identified "alcoholic beverages except beers," encompass the more narrowly identified "distilled spirits, namely, spirits distilled from the blue tequilana weber variety of agave plant" provided by those persons certified by Opposer.<sup>7</sup> In other words, the distilled spirits certified under Opposer's mark are subsumed under the more generally identified alcoholic beverages recited in the involved application. *See, e.g., Southwestern Mgmt., Inc. v. Ocinomled, Ltd*, 115

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<sup>7</sup> Opposer's TTB website excerpts generally indicate that tequila is a distilled spirit and that distilled spirits are alcoholic beverages. 5 TTABVUE 19-27.

USPQ2d 1007, 1025 (TTAB 2015) (With a broad identification of services, “we must presume that the services encompass all services of the type identified.”). As a result, the goods in Applicants’ application are legally identical to the goods listed in Opposer’s registration.

The third *DuPont* factor concerns “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *Stone Lion Capital v. Lion Capital*, 110 USPQ2d at 1161 (quoting *DuPont*, 177 USPQ at 567). Inasmuch as the goods identified in the application and Opposer’s pleaded registration are legally identical, we must presume that the channels of trade and classes of purchasers for these goods are the same. See *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011).

In view thereof, the second and third *DuPont* factors strongly favor a finding of a likelihood of confusion.

### C. Similarity of the Marks

Turning to the first *DuPont* factor, involving the comparison of the marks, we consider them “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721 (citation omitted). The

appropriate emphasis is on the recollection of the average customer, who normally retains a general rather than a specific impression of trademarks. *Spoons Rests., Inc. v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991) (citations omitted), *aff'd mem. unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). See *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014).

Additionally, where, as is the case here, the goods of an applicant and opposer are in part identical or virtually identical, the degree of similarity between the marks required to support a finding that confusion likely declines. See *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)).

Applicants' mark is TEQUILUSA in standard characters and Opposer's mark is TEQUILA in the equivalent typed characters. The marks are highly similar in appearance, sharing the root term "TEQUIL" and differing only in the addition of the letters "US" before the letter "A" at the end of Applicants' mark. The proper pronunciation of TEQUILA is well-known, even though it is well settled that there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Regardless of how consumers pronounce TEQUILA and TEQUILUSA, due to the similarities in the manner in which the terms comprising the marks are structured, their pronunciations will be similar. In all important respects, we find Applicants'

mark highly similar in appearance and sound to Opposer's mark, giving the impression of being minor variations of one another. *Cf. Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (finding STONE LION CAPITAL confusingly similar to LION and LION CAPITAL).

With regard to meaning, Opposer's evidence establishes that it certifies TEQUILA as a type of "distilled spirits, namely, spirits distilled from the blue tequilana weber variety of agave plant."<sup>8</sup> Applicants' TEQUILUSA mark suggests "Tequila" originating in or from the "USA" or United States of America.<sup>9</sup> Thus, Applicants' mark suggests a subset of Opposer's TEQUILA emanating from or associated with the United States of America. As a result, the marks TEQUILA and TEQUILUSA are highly similar in appearance and sound, and highly similar in meaning. Similarity in any one of these factors is sufficient to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988) ("In appropriate cases, a finding of similarity as to any one factor (sight, sound or meaning) alone 'may be sufficient to support a holding that the marks are confusingly similar.'") (citations omitted).

For the foregoing reasons, we find that Applicants' TEQUILUSA mark and Opposer's TEQUILA certification mark to be far more similar than dissimilar in

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<sup>8</sup> 5 TTABVUE 19-27.

<sup>9</sup> 5 TTABVUE 29-37. Opposer's evidence includes dictionary definitions from, inter alia, MacMillan Dictionary ([macmillandictionary.com](http://macmillandictionary.com)).

overall connotation and commercial impression, and highly similar in appearance and sound. Thus, the first *DuPont* factor favors a finding of likelihood of confusion.

#### **IV. Balancing the Section 2(d) Factors**

We have considered all of the arguments and evidence of record, including any not specifically discussed herein, and all relevant *DuPont* factors. Applicants' standard character mark, TEQUILUSA, is highly similar in appearance, sound, meaning and commercial impression to Opposer's pleaded certification mark, TEQUILA, in the equivalent typed form. Moreover, the goods at issue are legally identical and they are presumed to be marketed through the same trade channels to the same consumers. The remaining *DuPont* factors are neutral. We find that Applicants' mark so resembles Opposer's pleaded certification mark as to be likely to cause confusion or to cause mistake or to deceive.

**Decision:** The opposition to Application Serial No. 87861148 is sustained under Section 2(d) of the Trademark Act and registration is refused.

In view thereof, we need not, and do not, determine Opposer's remaining claims under Trademark Act Sections 2(e)(1) and 2(a). *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013) (the Board's determination of registrability does not require, in every instance, decision on every pleaded claim).